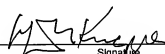


<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>4366-155</b>							
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on <u>July 9, 2008</u> Signature <u>Leslie M. Frankel</u>  Typed or printed name <u>Leslie M. Frankel</u>		<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="padding: 2px;">Application Number <b>10/667,110</b></td> <td style="padding: 2px;">Filed <b>2003-09-17</b></td> </tr> <tr> <td colspan="2" style="padding: 2px;">First Named Inventor <b>Christopher R. Gentle</b></td> </tr> <tr> <td style="padding: 2px;">Art Unit <b>2179</b></td> <td style="padding: 2px;">Examiner <b>TUYETLIEN T. TRAN</b></td> </tr> </table>		Application Number <b>10/667,110</b>	Filed <b>2003-09-17</b>	First Named Inventor <b>Christopher R. Gentle</b>		Art Unit <b>2179</b>	Examiner <b>TUYETLIEN T. TRAN</b>
Application Number <b>10/667,110</b>	Filed <b>2003-09-17</b>								
First Named Inventor <b>Christopher R. Gentle</b>									
Art Unit <b>2179</b>	Examiner <b>TUYETLIEN T. TRAN</b>								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).          Note: No more than five (5) pages may be provided.</p>									
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,189</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<div style="text-align: center;">         Signature  <b>Bradley M. Knepper</b>        Typed or printed name        (303) 863-9700        Telephone number  <u>July 9, 2008</u>        Date     </div>							
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.									
<input type="checkbox"/> *Total of _____ forms are submitted.									

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

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1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of: ) Group Art Unit: 2179  
)  
Christopher R. Gentle ) Examiner: TRAN, TUYETLIEN T.  
)  
Serial No.: 10/667,110 ) Confirmation No.: 8515  
)  
Filed: September 17, 2003 ) REASONS SUPPORTING PRE-APPEAL  
) BRIEF REQUEST FOR REVIEW  
)  
Atty. File No.: 4366-155 )  
)  
For: "PASSIVE LOOK AHEAD FOR USER  
INTERFACES"

CERTIFICATE OF TRANSMISSION	
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING TRANSMITTED VIA THE OFFICE ELECTRONIC FILING SYSTEM IN ACCORDANCE WITH 37 CFR §1.6(a)(4) ON <u>July 9, 2008</u>	
SHERIDAN ROSS P.C.	
BY:	<u><i>Dennis Frankel</i></u>

Mail Stop After Final  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The following sets forth Applicant's Reasons in Support of the Pre-Appeal Brief Request for Review submitted herewith. Also submitted herewith is a Notice of Appeal and a Request for a Pre-Appeal Brief Conference, together with the associated fees. Although no additional fees are believed due in connection with the filing of these papers, please charge any such fees deemed necessary, or credit any overpayment, to Deposit Account No. 19-1970.

The Examiner's objections omit essential elements needed to reject the pending claims. In particular, the cited references do not teach, suggest or describe a method or apparatus as claimed, in which a preview of an actual consequence of actually selecting a selectable item includes an operation that is performed on a file that is open in a computer program presenting the first selectable item. Accordingly, it is submitted that all of the pending claims are in condition for allowance.

Claims 31-35 stand rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,995,101 to Clark et al. ("Clark"). Claims 1-15, 17-23 and 25-30 stand rejected under 35

U.S.C. § 103 as being obvious over Clark in view of U.S. Patent Application Publication No. 2004/0205514 A1 to Sommerer et al. (“Sommerer”), and claim 16 stands rejected under 35 U.S.C. § 103 as being obvious over Clark in view of Sommerer and further in view of U.S. Patent No. 6,243,724 to Mander et al (“Mander”). However, all of the claim elements cannot be found in the cited references, whether those references are considered alone or in combination. Accordingly, reconsideration and withdrawal of the rejections of the claims as anticipated by or obvious in view of the cited references are respectfully requested.

The invention as claimed provides a preview of the actual consequence that actually selecting a selectable item presented by a program or application will have on a file that is open in the program or application. For example, as recited by amended independent Claim 1, the selectable item is not a representation of a file, and the actual consequences of actually selecting the selectable item that is displayed include an operation that is performed on a file that is open in a computer program presenting the first selectable item. Claim 1 further specifies that the depiction of the actual consequence of actually selecting the selectable item is displayed in the absence of an actual selection of the selectable item. As set forth in independent Claim 17, a cursor hovering over a first selectable item causes a preview of an actual consequence of actually selecting a first selectable item to be displayed. In addition, the actual selection of the first selectable item performs an operation on a file that is open within an application that provides said first selectable item. Independent Claim 31 recites an apparatus for displaying a consequence of a selection to a user that includes “means for generating a depiction of an actual consequence of actually selecting said selectable item . . . wherein said selectable item is associated with an application program, wherein said actual consequence of selecting such selectable item performs an operation, and wherein said operation does not include opening a file.” Independent Claim 34 recites displaying a depiction of the actual consequences of actually selecting at least a first selectable item, wherein the actual consequences of selecting the first selectable item do not include opening a file. Accordingly, by way of illustration and not necessarily importing limitations into the claims, embodiments of the claimed invention provide the user with a preview of the effect or consequence of performing an operation on a file by selecting a selectable item. As such elements are not taught, suggested or described by the cited references, the rejections of the

claims as unpatentable in view of those references should be reconsidered and withdrawn.

The Examiner has argued that the Applicant's responses to the obviousness rejections presented in the previous Amendment and Response fail because they point out the deficiencies of those references individually. However, even taken in combination, the cited references do not teach, suggest or describe each and every element of the claims. Indeed, it is unclear how the absence of an element of the claims from the Examiner's rejections can be articulated other than by a discussion of the references individually, since it is not apparent how the proposed combination of those references would somehow result in a teaching of that element. Moreover, Applicant notes that a proposed combination of references much teach or suggest all of the claim limitations. In particular, the proposed combination does not provide a method or apparatus that previews a consequence that selecting an item will have on a file that is open in an application. Because the proposed combination of references does not teach or suggest all of the claim limitations, the rejections of the claims should be reconsidered and withdrawn.

The Office Action admits that the Clark reference does not provide a preview of an actual consequence of selecting an item. Instead, Clark is cited for displaying a demonstration of an icon's function in the form of a tool tip. The Sommerer reference is cited for disclosing a hyperlink preview utility. From these disclosures, the Examiner concludes that it would be obvious to modify Clark to display an operation that is performed on a file that is open in a program presenting the first selectable item. However, the Office Action fails to provide support for such a conclusion, except to suggest that the combination of Clark and Sommerer benefits from some undescribed synergistic effect to arrive at the claimed invention. Accordingly, the rejections of the claims appear to be an example of using the Applicant's disclosure as a template for the obviousness rejection, rather than a demonstration that the claimed invention would be obvious to one of ordinary skill in the art. In particular, given the absence of any disclosure in the cited references of providing a preview of an actual consequence of selecting an item, much less providing a preview of an operation that is performed on a file that is open in a computer program presenting the first selectable item, it is unclear from the Office Action how the references in combination teach such a result. Instead, the Office Action simply states that one of skill in the art would infer that from the

references.

The Office Action does discuss how the Clark reference provides tool tips that can be applied to control areas in a graphical user interface. However, Clark's tool tips and Sommerer's preview of a target resource page are not a suggestion to preview an actual consequence of selecting a first selectable item where the actual consequence is performed on a file that is open in a computer program presenting the first selectable item. Instead, Clark provides fixed descriptions or demonstrations of an icon's function, without operating on an application that is open in the program presenting the icon, while Sommerer discusses displaying a preview of a target resource page associated with a linking control, without operating on an application that is open in the program presenting the icon. Considered in combination, the disclosure of these references does not result in a suggestion to provide a preview of an actual consequence of selecting a selectable item that includes an operation performed on a file that is open in the application as generally claimed.

The Clark reference is generally directed to a multi-level tool tip. In particular, when a user points to an area of interest in a graphical display on a computer monitor using a cursor, a first level of information is displayed. A subsequent level of information is then displayed if the user continues to point to that area of interest or if a selected key stroke is entered (Clark, abstract). In general, the tips provide textual explanations of an icon's function, or a demonstration of the function. (Clark, column 2, lines 30-63.) Accordingly, Clark is limited to presenting information describing a selected item or presenting an example of the effect of selecting an item. Clark does not teach, suggest or describe providing a preview of the actual consequence of selecting an item. The failure of Clark to provide a preview of a consequence of selecting a selectable item is acknowledged by the Office Action. (See final Office Action dated April 14, 2008, page 3 and page 14.)

The Sommerer reference is generally directed to a hyperlink preview utility and method. In particular, Sommerer discusses displaying a preview of a target resource page associated with a linking control, such as a hyperlink or visit node. (Sommerer, paragraph 8.) According to Sommerer, the preview is displayed adjacent to the linking control and may display layout and content information to a user. (*Id.*) However, Sommerer does not teach, suggest or describe previewing an actual consequence of an operation performed on a file that

is open in a computer program presenting an item that can be selected to perform the operation. Instead, Sommerer provides a preview of a resource page. Previewing a resource page is different than previewing the actual consequence of an operation on a file that is open in a computer program presenting a selectable item where the operation can be performed by actually selecting the selectable item. Therefore, Sommerer does not suggest the limitations of the claims missing from Clark. Moreover, the combination of a tool tip as discussed by Clark and a preview of a target resource page does not provide a teaching or suggestion of previewing the actual consequence of an operation that is performed on a file that is open in a computer program.

The final Office Action cites U.S. Patent No. 6,160,554 to Krause for teaching the use of a projection line when a preview window is invoked. However, the Krause reference does not discuss providing a preview of an actual consequence of making a selection as claimed, and therefore even if Krause is combined with the Clark and Sommerer references, it does not teach, suggest or describe all the elements of the pending claims.

The cited references do not disclose displaying a preview of an actual consequence of a selection on a file that is open in an application as claimed. Indeed, there is no suggestion in the prior art to provide a preview of the actual consequence on a file that is open in a computer program resulting from a selection of an item presented by that computer program, even if the cited references are considered in combination. Accordingly, the rejections of the claims as obvious should be reconsidered and withdrawn, and the claims should be allowed.

The Pre-Appeal Brief Conference participants are invited to contact the undersigned by telephone if there are any questions or if doing so would expedite the resolution of this matter.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: 

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Date: July 9, 2008